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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Richard PELLEGRINI et al. Group Art Unit: 3764

Application No.: 09/988,335 Examiner: M. Brown

Filed: November 19, 2001 Docket No.: 106679.01

For: DISPOSABLE EYE PATCH AND METHOD OF MANUFACTURING A DISPOSABLE EYE PATCH

## RESPONSE TO JANUARY 10, 2005 OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The Office Action mailed January 10, 2005 asserts that Applicants' November 1, 2004 Response did not elect one of the groups presented by the Examiner. However, Applicants respectfully note that page 2, lines 6-7 of the November 1 Response state that "Applicants hereby provisionally elect the species identified as 'Group IV, claims 24-40, 45 and 50.'"

For the convenience of the Examiner, Applicants' entire response, including reasons for traversal of the election of species requirement, is repeated below.

The Office Action dated September 30, 2004 asserts that there are four patentably distinct species of the claimed invention, and asserts that these species are "Group I, claims 1-2, 41-42, 46-47; Group II, claims 3, 43, 48; Group III, claims 4-23, 44, 49; and Group IV, claims 24-40, 45 and 50." The Office Action errs in its identification of species.

M.P.E.P. §806.04(e) makes it clear that "[c]laims are never species." (emphasis in original). Therefore, the Election Requirement applied in this application is improper on its

face, because it only identifies "species" in terms of claims. As also stated in M.P.E.P. §806.04(e), "[s]pecies are always the specifically different embodiments" (emphasis added). This application discloses a "disposable eye patch" in Figs. 1-9, including a "disposable, laser resistant eye patch," exemplary embodiments of which are shown in Figs. 8 and 9. Applicants respectfully submit that it would be more appropriate to classify the species in this application as "Species I, Figs. 1-7; Species II, Fig. 8; and Species III, Fig. 9." If the Patent Office agrees to this classification, then Applicants elect Species III, Fig. 9. Claims 1-50 are readable on the elected species, and claims 24-40, 45 and 50 are generic to Species II and III.

The election requirement asserted by the Office Action is improper as discussed herein, but because Applicants must make an election in response to this requirement, in the event that the Patent Office does not agree to Applicant's proposed classification set forth above, Applicants hereby provisionally elect the species identified as "Group IV, claims 24-40, 45 and 50." Regardless, the election is made with traverse.

The election requirement is improper as discussed above, and must therefore be withdrawn. Furthermore, Applicants' proposed Species II and Species III are very related. Each claim of this application is directed to Applicants' proposed Species II and/or Applicants' proposed Species III. Therefore, it is respectfully submitted that the subject matter of Applicants' proposed Species II and Species III is sufficiently related that a thorough search for the subject matter of either species would encompass a search for the subject matter of the other species. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this

policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Election of Species Requirement is respectfully requested.

Respectfully submitted,

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Date: January 28, 2005

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